



TRANSMITTAL FORM

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/731,796-Conf. #4319	
	Filing Date	December 9, 2003	
	First Named Inventor	Stephen J. Todd	
	Art Unit	2186	
	Examiner Name	L. Iwashko	
Total Number of Pages in This Submission	12	Attorney Docket Number	E0295.70196US00

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Issue Fee Transmittal (Part B)	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> After Allowance Communication to TC
<input checked="" type="checkbox"/> Check for \$1,700.00 Attached	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input checked="" type="checkbox"/> Amendment After Allowance Under 37 CFR § 1.312	<input type="checkbox"/> Petition	<input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Petition to Convert to a Provisional Application	<input type="checkbox"/> Proprietary Information
<input type="checkbox"/> Affidavits/declaration(s)	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> Terminal Disclaimer	<input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Request for Refund	<ul style="list-style-type: none">• Return Receipt Postcard
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> CD, Number of CD(s) _____	
<input checked="" type="checkbox"/> Comments on Statement of Reasons for Allowance	<input type="checkbox"/> Landscape Table on CD	
<input type="checkbox"/> Reply to Missing Parts/Incomplete Application	Remarks	
<input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	WOLF, GREENFIELD & SACKS, P.C.		
Signature			
Printed name	Richard F. Giunta		
Date	October 23, 2006	Reg. No.	36,149

Certificate of Mailing Under 37 CFR 1.8(a)

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service on the date shown below with sufficient postage as First Class Mail, in an envelope addressed to: Mail Stop Issue Fee, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: October 23, 2006

Signature: (Richard F. Giunta)



Docket No.: E0295.70196US00
(PATENT)

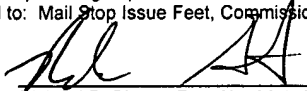
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Stephen J. Todd et. al.
Serial No.: 10/731796
Confirmation No.: 4319
Filed: December 9, 2003
For: METHODS AND APPARATUS FOR CACHING A LOCATION
INDEX IN A DATA STORAGE SYSTEM
Examiner: P. Bataille
Art Unit: 2186

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Dated: October 23, 2006


Richard F. Giunta, Reg. No. 36,149

Mail Stop Issue Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMMENTS ON STATEMENT OF REASONS FOR ALLOWANCE

Sir:

The Notice of Allowance and Fee(s) Due mailed July 26, 2006, included an Examiner's Amendment and an Examiner's Statement of Reasons for Allowance.

As discussed in the Rule 312 Amendment filed concurrently herewith, the Notice of Allowance included an Examiner's Amendment that added language into independent claims 1, 9, and 17 that was never discussed with or authorized by Applicant.

The Examiner's statement of reasons for allowance states, "[t]he examiner attended an Applicant-initiated telephonic interview, where applicant brought up a possible amendment to the claims that would make the claims novel. Upon review of the proposed amendments, the Examiner agreed that the proposed amendments were almost in condition for allowance. The Examiner then made a final Examiner Amendment for claims 1, 9, and 17 as shown above."

Applicants disagree with this characterization of the telephone interview conducted with the Examiner on June 26, 2006.

Specifically, Applicants do not agree that the amendment proposed was necessary to “make the claims novel,” as Applicant believes the unamended claims to be patentable over the cited art. The amendment was proposed merely to expedite allowance of the application, not because Applicant believed the claims as originally filed to be unpatentable over the prior art. In addition, Applicant disagrees that the Examiner indicated the proposed amendments “were almost in condition for allowance.” To the contrary, the Examiner explicitly stated that if the proposed amendments were made to independent claims 1, 9, and 17, he would allow the application. The Examiner then agreed to make the proposed amendment by Examiner’s Amendment. The language added by Examiner’s Amendment in claims 1, 9, and 17, that recites, “and responding to the host during any write request by writing an entry into the cache that states that the write has been completed successfully,” was never discussed during the telephone interview with Examiner Iwashko and was never authorized by Applicant.

There are three independent claims allowed (claims 1, 9, and 17). The Statement of Reasons for Allowance does not separately address each independent claim, but indicates that these claims “differ only in being different embodiments of the invention (method, system, or apparatus).” The Statement of Reasons for Allowance discussed the allowability of claim 1, but indicated that the explanation applies to the other independent claims as well.

Applicant believes that each of the claims is patentable based solely upon the language included therein, and that the shorthand reference to the claims teaching “the same concepts” and as purportedly differing only in being different embodiments is not intended to incorporate any limitation from one of the claims into another where it is not present. If the Examiner disagrees, he is respectfully requested to contact the undersigned at the number listed below to discuss how the record can be clarified.

In addition, the statement of reasons for allowance indicates that the novelty of claim 1 comes from the latter part of the claim, which includes the unauthorized language added by Examiner’s Amendment. Applicant would like to emphasize that the unauthorized language added to claim 1 by Examiner’s Amendment is not necessary to distinguish claim 1 over the

prior art, and that claim 1 is patentable over the prior art of record based upon the subject matter recited therein as a whole, as opposed to any particular allegedly novel limitation(s).

If the Examiner disagrees with any of the foregoing, he is respectfully requested to contact the undersigned at the number listed below so that a discussion can be had about clarifying the record as to the scope of the allowed claims and the reasons for allowance.

Dated: October 23, 2006

Respectfully submitted,

By:  

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